IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Slatter, *et al.*	)	Confirmation No: 4921
	)	Group Art Unit: 2622
Serial No.: 10/078,742	)	
	)	Examiner: Ye, Lin
Filed: February 19, 2002	)	
	)	Atty. Docket No.: 30004064-2
For: WEARABLE TRANSMITTING/ RECEIVING DEVICE	)	

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed November 13, 2006, responding to the final Office Action mailed July 11, 2006.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-8, 10-14, and 18-23 stand finally rejected. No claims have been allowed. Claims 9 and 15-17 have been canceled. The final rejections of claims 1-8, 10-14, and 18-23 are appealed.

IV. Status of Amendments

This application was originally filed on February 19, 2002, with nineteen (19) claims. In a Response filed June 7, 2005, Applicant amended claims 1-2, 4-5, 8, 10-13, and 18-19, canceled claims 9 and 15-17, and added claims 20-22. In a Response filed November 9, 2005, Applicant amended claims 18-19. In a Response filed April 24, 2006, Applicant added claim 23. In a Response filed October 10, 2006, Applicant presented remarks without

any claim amendments. The claims in the attached Claims Appendix (see below) reflect the present state of Applicant's claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments according to independent claim 1 describe a wearable electromagnetic (EM) radiation transmitter/receiver. The transmitter/receiver comprises a front portion (Figure 1, 30) and a rear portion (Figure 1, 26). The front portion (Figure 1, 30) includes a transmission (Figure 1, 31) and reception (Figure 1, 28) sections and is adapted to be worn outside a wearer's clothing (Figure 1, 27). The rear portion (Figure 1, 26) includes a control section (Figure 1, 26c and 26d) and is worn inside at least part of the wearer's clothing (Figure 1, 27). The front (Figure 1, 30) and rear portions (Figure 1, 26) are operable to communicate with one another. The transmitter/receiver further comprises a means to secure the front and the rear portion in position on a wearer's clothing (Figure 1, 27). The securing means (Figure 1, 29) is configured when in use to be operable through a thickness of the wearer's clothing (Figure 1, 27) between the front (Figure 1, 30) and the rear portion (Figure 1, 26). Applicant's specification, pages 1-3, lines 23-30 and pages 4-8, lines 11-18.

Embodiments according to independent claim 18 describe a wearable electromagnetic (EM) radiation transmitter/receiver. The transmitter/receiver comprises a front portion (Figure 1, 30) and a rear portion (Figure 1, 26). The front portion (Figure 1, 30) includes transmission (Figure 1, 31) and reception sections (Figure 1, 28) and is adapted to be worn outside a wearer's clothing (Figure 1, 27). The rear portion (Figure 1, 26) includes a control section (Figure 1, 26c-d) and is adapted to be worn inside at least part of the wearer's clothing (Figure 1, 27), in which the front (Figure 1, 30) and rear portions (Figure 1, 26) are operable to communicate electrically with one another, and are physically connected to one another, in which the front (Figure 1, 30) and rear portions (Figure 1, 26) are electrically connected by means of an electrically conducting connection pin (Figure 1, 29) that penetrates the wearer's clothing (Figure 1, 27) and fixes the front (Figure 1, 30) and rear portions (Figure 1, 26) in place. Applicant's specification, pages 1-3, lines 23-30 and pages 4-8, lines 11-18.

Embodiments according to independent claim 19 describe a wearable electromagnetic (EM) radiation transmitter/receiver. The transmitter/receiver comprises a front portion (Figure 1, 30) and a rear portion (Figure 1, 26). The front portion (Figure 1, 30) includes transmission (Figure 1, 31) and reception sections (Figure 1, 28) and is adapted to be worn outside a wearer's clothing (Figure 1, 27). The rear portion (Figure 1, 26) includes a control section (Figure 1, 26c-d) and is adapted to be worn inside at least part of the wearer's clothing (Figure 1, 27), in which the front (Figure 1, 30) and rear portions (Figure 1, 26) are operable to communicate electrically with one another, in which the front portion (Figure 1, 30) is secured to the rear portion (Figure 1,

26) and to the wearer's clothing (Figure 1, 27) by mating the front portion (Figure 1, 30) that is outside of the wearer's clothing (Figure 1, 27) with the rear portion (Figure 1, 26) that is inside the wearer's clothing (Figure 1, 27) via a securing means (Figure 1, 29). Applicant's specification, pages 1-3, lines 23-30 and pages 4-8, lines 11-18.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejections are to be reviewed on appeal:

Claims 1, 4-8, 13-14, and 18-22 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* (U.S. Patent No. 5,912,653) in view of *Lin* (U.S. Patent No. 4,965,705).

Claims 2 and 10-12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* in view of *Lin* in further view of *Brett* (U.S. Patent No. 3,141,216).

Claim 3 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* in view of *Lin* in further view of *Kweon* (U.S. Patent No. 6,667,771 B1).

Claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* in view of *Lin* in further view of *Kakita* (U.S. Patent No. 5,014,079).

VII. Arguments

The Appellant respectfully submits that Applicant's claims 1-8, 10-14, and 18-23 are patentable under 35 U.S.C. §103. The Appellant respectfully requests that the Board of Patent Appeals overturn the final rejection of those claims at least for the reasons discussed below.

A. Applicant's Claims 1, 4-8, 13-14, and 18-22

Claims 1, 4-8, 13-14, and 18-22 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* (U.S. Patent No. 5,912,653) in view of *Lin* (U.S. Patent No. 4,965,705).

1. The *Fitch* Disclosure

Fitch describes a garment with a flat panel color liquid crystal display embedded in the garment. *Fitch* describes that the liquid crystal display is clamped in place by a slide lock fastener that is sewn into the garment and a second fastener that is bonded to an inner side of the garment. *See* col. 3, lines 4-15. *Fitch* further describes that a GPS system is built into the garment to provide security against theft. *See* col. 4, lines 41-47.

2. The *Lin* Disclosure

Lin describes an electronic badge that is clamped to a wearer's clothing using two pins that are engaged in two clips. *See* col. 2, lines 47-52.

3. Applicant's Claim 1

As provided in independent claim 1, Applicant claims:

> A wearable electromagnetic (EM) radiation transmitter/receiver comprising:
> a front portion;
> a rear portion, wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is worn inside at least part of the wearer's clothing, the front and rear portions being operable to communicate with one another; and

> ***a means to secure the front and the rear portion in position on a wearer's clothing, the securing means being configured when in use to be operable through a thickness of the wearer's clothing between the front and the rear portion.***

(Emphasis added).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Fitch* in view of *Lin* is inadequate in teaching or suggesting at least "a means to secure the front and the rear portion in position on a wearer's clothing, the securing means being configured when in use to be operable through a thickness of the wearer's clothing between the front and the rear portion," as recited in claim 1.

Fitch appears to teach at most a liquid crystal display (LCD) that is fastened using a slide lock fastener, such as that provided by Velcro, sewn into a jacket. *See* col. 3, lines 4-15. Accordingly, *Fitch* fails to teach or suggest "the securing means being configured when in use to be operable through a thickness of the wearer's clothing between the front and the rear portion, since *Fitch* teaches that two separated pieces of slide lock fastening fabric (fastener 16 and second fastener 29) are sewn on the jacket to hold the LCD display 12 and microcontroller 22 & circuit board 24 to the jacket, where each piece of lock fastening fabric is not operable through the thickness of the jacket. Accordingly, *Fitch* does not suggest that the fastener is desired to be operable through the thickness of the jacket and therefore, the proposed combination of *Fitch* in view of *Lin* is legally inadequate to establish a *prima facie* case of obviousness.

Moreover, *Fitch* further teaches that a GPS system is built into the garment to provide security against theft. *See* col. 4, lines 41-47. *Lin*, on the

other hand, teaches an electronic badge that is clamped to a wearer's clothing using two pins that are engaged in two clips. *See* col. 2, lines 47-52. In considering the combination of references, the fastening mechanism taught by *Lin* seems to teach against the type of fastening mechanism that *Fitch* suggests should be used for its liquid crystal display. When *Fitch* is so obviously concerned with securing the liquid crystal display to a garment to protect the device and to prevent theft (*e.g.*, sewing and bonding a lock fastener to the garment), it is not understood how a fastening mechanism taught by *Lin* is consistent with those objectives.

In the Advisory Action of October 23, 2006, the Examiner refuted this point and put forth the suggestion that the GPS system is used to locate a jacket by itself irrespective of the presence of the liquid crystal display. Page 2. Applicant respectfully submits, however, that the GPS system 74 is part of the circuitry 88 for the liquid crystal display and is not an indirect, independent, or ancillary component that exists to locate a jacket irrespective of presence of a liquid crystal display. Rather, *Fitch* clearly suggests that the GPS system 74 exists to make sure that a jacket and liquid crystal display are not stolen.

Further, *Fitch* discloses that "the electronics of the invention on the circuit board, is suitably housed to protect it and then preferably is mounted inside the garment by, for example, a slide lock fastener material bonded to the inside of the jacket to hold the electronics and the liquid crystal display in place." Col. 5, lines 48-52 (Emphasis added). Also, *Fitch* states that a "second fastener 20 is bonded to an inner side of the jacket and clamps a microcontroller 22 and circuit board 24 to the jacket. Although, a single

microcontroller 22 is illustrated, it is understood that any number of microcontrollers 22 and displays 12 may be used." Col. 3, lines 9-13 (Emphasis added). Also, FIG. 6 of *Fitch* shows a circuit board 88 having microcontroller 22 and transmitter/receiver (x + r) 72, where the circuit board 88 does not contain LCD 12. As such, *Fitch* seemingly discloses that a transmitter/receiver is located inside the garment. For at least this reason, *Fitch* fails to teach or suggest "wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing," as recited in the claim.

Additionally, in the final Office Action mailed July 11, 2006, it states that the "Fitch reference never states the garment electronic cannot use other type of fastening mechanism, such as pins engaged in to clips." Page 2. In response, Applicant submits that *Fitch* appears to provide no suggestion or motivation for modifying its teachings to include the suggested fastening mechanisms since they do not appear to be consistent with the teachings of *Fitch*. Referencing back to the final Office Action, it further states that a GPS system is built into the *Fitch* garment to provide security against theft. The final Office Action states that "The GPS system is nothing to do with choosing what type of fastening mechanism for securing the electronic device on the garment (cloth)." Page 2. Further, the final Office Action states that the "Lin reference is evidence that one of ordinary skill in the art at the time to see more advantages the wearable electronic device using an electrically conducting connection pen to secure the front and rear portions so that wearer can easily attach or detach both front and rear portions of device from cloth." Page 3. In response, Applicant notes that *Fitch* discloses that the

GPS unit 74 is "to provide for security against theft. Information as to the location of the jacket can be used and broadcast to inform law enforcement as well as friends to give information of the position of and location of the wearer of the jacket." Col. 4, lines 43-47. Therefore, the liquid crystal display in *Fitch* is seemingly intended to be fastened securely to a jacket, such that theft of the jacket itself is more likely than then theft of the liquid crystal display by itself. As such, the reasoning for the proposed modifications of allowing easily attachment and detachment of front and rear portions using "pins engaged in to clips" does not appear to be supported by the *Fitch* reference. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985)("Critical to the analysis is an understanding of the particular results achieved by the new combination") and *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)(If a reference would be "rendered inoperable for its intended purpose" when it is modified for use as prior art, then the reference "teaches away" and should not be used).

As a result, Applicant respectfully submits that the proposed combination is not obvious and the rejection should be withdrawn for the foregoing reasons.

4. Applicant's Claims 4-8, 13-14, and 20-22

Because independent claim 1 is allowable over the cited art of record, dependent claims 4-8, 13-14, and 20-22 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 4-8, 13-14, and 20-22 contain all the features of independent claim 1. Therefore, a *prima facie* case establishing an

obviousness rejection by the proposed combination of *Fitch* in view of *Lin* has not been made with regard to claims 4-8, 13-14, and 20-22. Therefore, the rejections of claims 4-8, 13-14, and 20-22 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for allowability of claims 4-8, 13-14, and 20-22, these claims recite further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the cited art of record. Accordingly, the rejections to these claims should be withdrawn.

For example, with regard to claim 5, *Fitch* appears to teach at most a liquid crystal display (LCD) embedded into a garment. The liquid crystal display is disclosed to be an output device that can display digital and analog video signals. Accordingly, the liquid crystal display is not disclosed to be an image capture means. While *Fitch* does suggest that inputs from an analog video storage device may be selected for display on the liquid crystal display, where a video camera 40, video recorder 38, and video tuner 36 are mentioned as video storage devices, *Fitch* clearly states that "these three storage devices are optional accessories and are external to the jacket." *See* col. 3, lines 34-44 and col. 4, lines 17-20. Therefore, *Fitch* in view of *Lin* fails to teach or suggest claim 5.

5. Applicant's Claim 18

As provided in independent claim 18, Applicant claims:

> A wearable electromagnetic (EM) radiation transmitter/receiver comprising:
> a front portion and
> a rear portion, ***wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear***

portion includes a control section and is adapted to be worn inside at least part of the wearer's clothing, in which the front and rear portions are operable to communicate electrically with one another, and are physically connected to one another, in which the front and rear portions are electrically connected by means of an electrically conducting connection pin that penetrates the wearer's clothing and fixes the front and rear portions in place.

(Emphasis added).

Applicant respectfully submits that independent claim 18 is allowable for at least the reason that *Fitch* in view of *Lin* is inadequate in teaching or suggesting at least the feature "wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is adapted to be worn inside at least part of the wearer's clothing, in which the front and rear portions are operable to communicate electrically with one another, and are physically connected to one another, in which the front and rear portions are electrically connected by means of an electrically conducting connection pin that penetrates the wearer's clothing and fixes the front and rear portions in place," as recited in claim 18.

Applicant fails to appreciate how it is obvious to combine *Fitch* with *Lin*. *Fitch* teaches a garment with a flat panel color liquid crystal display embedded in the garment. *Fitch* teaches that the liquid crystal display is clamped in place by a slide lock fastener that is sewn into the garment and a second fastener that is bonded to an inner side of the garment. *See* col. 3, lines 4-15. *Fitch* further teaches that a GPS system is built into the garment to provide security against theft. *See* col. 4, lines 41-47. *Lin*, on the other hand, teaches an electronic badge that is clamped to a wearer's clothing using two pins that are engaged in two clips. *See* col. 2, lines 47-52. In considering the

combination of references, the fastening mechanism taught by *Lin* seems to teach against the type of fastening mechanism that *Fitch* suggests should be used for its liquid crystal display. When *Fitch* is so obviously concerned with securing the liquid crystal display to a garment to protect the device and to prevent theft (*e.g.*, sewing and bonding a lock fastener to the garment), it is not understood how a fastening mechanism taught by *Lin* is consistent with those objectives. Applicant respectfully submits that the proposed combination is not obvious and the rejection should be withdrawn.

Further, *Fitch* discloses that "the electronics of the invention on the circuit board, is suitably housed to protect it and then preferably is mounted inside the garment by, for example, a slide lock fastener material bonded to the inside of the jacket to hold the electronics and the liquid crystal display in place." Col. 5, lines 48-52 (Emphasis added). Also, *Fitch* states that a "second fastener 20 is bonded to an inner side of the jacket and clamps a microcontroller 22 and circuit board 24 to the jacket. Although, a single microcontroller 22 is illustrated, it is understood that any number of microcontrollers 22 and displays 12 may be used." Col. 3, lines 9-13 (Emphasis added). Also, FIG. 6 of *Fitch* shows a circuit board 88 having microcontroller 22 and transmitter/receiver (x + r) 72, where the circuit board 88 does not contain LCD 12. As such, *Fitch* seemingly discloses that a transmitter/receiver is located inside the garment. For at least this reason, *Fitch* fails to teach or suggest "wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing," as recited in claim 18.

Additionally, in the final Office Action mailed July 11, 2006, it states that the "Fitch reference never states the garment electronic cannot use other type of fastening mechanism, such as pins engaged in to clips." Page 2. In response, Applicant submits that *Fitch* appears to provide no suggestion or motivation for modifying its teachings to include the suggested fastening mechanisms since they do not appear to be consistent with the teachings of *Fitch*. Referencing back to the final Office Action, it further states that a GPS system is built into the *Fitch* garment to provide security against theft. The final Office Action states that "The GPS system is nothing to do with choosing what type of fastening mechanism for securing the electronic device on the garment (cloth)." Page 2. Further, the final Office Action states that the "Lin reference is evidence that one of ordinary skill in the art at the time to see more advantages the wearable electronic device using an electrically conducting connection pen to secure the front and rear portions so that wearer can easily attach or detach both front and rear portions of device from cloth." Page 3. In response, Applicant notes that *Fitch* discloses that the GPS unit 74 is "to provide for security against theft. Information as to the location of the jacket can be used and broadcast to inform law enforcement as well as friends to give information of the position of and location of the wearer of the jacket." Col. 4, lines 43-47. Therefore, the liquid crystal display in *Fitch* is seemingly intended to be fastened securely to a jacket, such that theft of the jacket itself is more likely than then theft of the liquid crystal display by itself. As such, the reasoning for the proposed modifications of allowing easily attachment and detachment of front and rear portions using "pins engaged in to clips" does not appear to be supported by the *Fitch* reference.

As a result, Applicant respectfully submits that the proposed combination is not obvious and the rejection should be withdrawn for the foregoing reasons.

6. Applicant's Claim 19

As provided in independent claim 19, Applicant claims:

> A wearable electromagnetic (EM) radiation transmitter/receiver comprising:
> a front portion and
> a rear portion, ***wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is adapted to be worn inside at least part of the wearer's clothing, in which the front and rear portions are operable to communicate electrically with one another, in which the front portion is secured to the rear portion and to the wearer's clothing by mating the front portion that is outside of the wearer's clothing with the rear portion that is inside the wearer's clothing via a securing means.***

(Emphasis added).

Applicant respectfully submits that independent claim 19 is allowable for at least the reason that *Fitch* in view of *Lin* is inadequate in teaching or suggesting at least the feature of "wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is adapted to be worn inside at least part of the wearer's clothing, in which the front and rear portions are operable to communicate electrically with one another, in which the front portion is secured to the rear portion and to the wearer's clothing by mating the front portion that is outside of the wearer's clothing with the rear portion that is inside the wearer's clothing via a securing means," as recited in claim 19.

Applicant fails to appreciate how it is obvious to combine *Fitch* with *Lin*. *Fitch* teaches a garment with a flat panel color liquid crystal display embedded in the garment. *Fitch* teaches that the liquid crystal display is clamped in place by a slide lock fastener that is sewn into the garment and a second fastener that is bonded to an inner side of the garment. *See* col. 3, lines 4-15. *Fitch* further teaches that a GPS system is built into the garment to provide security against theft. *See* col. 4, lines 41-47. *Lin*, on the other hand, teaches an electronic badge that is clamped to a wearer's clothing using two pins that are engaged in two clips. *See* col. 2, lines 47-52. In considering the combination of references, the fastening mechanism taught by *Lin* seems to teach against the type of fastening mechanism that *Fitch* suggests should be used for its liquid crystal display. When *Fitch* is so obviously concerned with securing the liquid crystal display to a garment to protect the device and to prevent theft (*e.g.*, sewing and bonding a lock fastener to the garment), it is not understood how a fastening mechanism taught by *Lin* is consistent with those objectives. Applicant respectfully submits that the proposed combination is not obvious and the rejection should be withdrawn.

Further, *Fitch* discloses that "the electronics of the invention on the circuit board, is suitably housed to protect it and then preferably is mounted inside the garment by, for example, a slide lock fastener material bonded to the inside of the jacket to hold the electronics and the liquid crystal display in place." Col. 5, lines 48-52 (Emphasis added). Also, *Fitch* states that a "second fastener 20 is bonded to an inner side of the jacket and clamps a microcontroller 22 and circuit board 24 to the jacket. Although, a single microcontroller 22 is illustrated, it is understood that any number of

microcontrollers 22 and displays 12 may be used." Col. 3, lines 9-13 (Emphasis added). Also, FIG. 6 of *Fitch* shows a circuit board 88 having microcontroller 22 and transmitter/receiver (x + r) 72, where the circuit board 88 does not contain LCD 12. As such, *Fitch* seemingly discloses that a transmitter/receiver is located inside the garment. For at least this reason, *Fitch* fails to teach or suggest "wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing," as recited in claim 19.

Additionally, in the final Office Action mailed July 11, 2006, it states that the "Fitch reference never states the garment electronic cannot use other type of fastening mechanism, such as pins engaged in to clips." Page 2. In response, Applicant submits that *Fitch* appears to provide no suggestion or motivation for modifying its teachings to include the suggested fastening mechanisms since they do not appear to be consistent with the teachings of *Fitch*. Referencing back to the final Office Action, it further states that a GPS system is built into the *Fitch* garment to provide security against theft. The final Office Action states that "The GPS system is nothing to do with choosing what type of fastening mechanism for securing the electronic device on the garment (cloth)." Page 2. Further, the final Office Action states that the "Lin reference is evidence that one of ordinary skill in the art at the time to see more advantages the wearable electronic device using an electrically conducting connection pen to secure the front and rear portions so that wearer can easily attach or detach both front and rear portions of device from cloth." Page 3. In response, Applicant notes that *Fitch* discloses that the GPS unit 74 is "to provide for security against theft. Information as to the

location of the jacket can be used and broadcast to inform law enforcement as well as friends to give information of the position of and location of the wearer of the jacket." Col. 4, lines 43-47. Therefore, the liquid crystal display in *Fitch* is seemingly intended to be fastened securely to a jacket, such that theft of the jacket itself is more likely than then theft of the liquid crystal display by itself. As such, the reasoning for the proposed modifications of allowing easily attachment and detachment of front and rear portions using "pins engaged in to clips" does not appear to be supported by the *Fitch* reference. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985)("Critical to the analysis is an understanding of the particular results achieved by the new combination") and *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)(If a reference would be "rendered inoperable for its intended purpose" when it is modified for use as prior art, then the reference "teaches away" and should not be used). As a result, Applicant respectfully submits that the proposed combination is not obvious and the rejection should be withdrawn for the foregoing reasons.

B. Applicant's Claims 2 and 10-12

Claims 2 and 10-12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* in view of *Lin* in further view of *Brett* (U.S. Patent No. 3,141,216).

Because independent claim 1 is allowable over the cited art of record, dependent claims 2 and 10-12 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 2 and 10-12 contain all the features of independent claim 1 and the cited art of

Brett fails to cure the deficiencies of the *Fitch* and *Lin* references in suggesting or teaching all of the claimed features in claims 2 and 10-12 (which depend from independent claim 1). Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Fitch* in view of *Lin* in further view of *Brett* has not been made with regard to claims 2 and 10-12. Therefore, the rejections of claims 2 and 10-12 should be withdrawn.

C. Applicant's Claim 3

Claim 3 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* in view of *Lin* in further view of *Kweon*. *Kweon* describes a "portable camera [that] includes a case having a ball-point pen appearance." Col. 1, lines 41-42. Therefore, *Kweon* discloses a front portion or front face of the ball-point pen structure with hole 27 and a clip 25 mounted on the front face of the ball-point pen structure. A rear portion or rear face of the ball-point pen structure opposes the front portion. Further, the "clip 25 is properly structured to fix the portable camera to a pocket of a shirt." Col. 3, lines 49-50.

Because independent claim 1 is allowable over the cited art of record, dependent claim 3 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim 3 contains all the features of independent claim 1 and the cited art of *Kweon* fails to cure the deficiencies of the *Fitch* and *Lin* references in suggesting or teaching all of the claimed features in claim 3. Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Fitch* in view of *Lin* in

further view of *Kweon* has not been made with regard to claim 3, and, the rejections of claim 3 should be withdrawn.

For example, in *Kweon*, clothing is not positioned between the front and rear portions of the ball-point pen structure, since clothing is maintained on the exterior of the front and the rear portions of the ball-point pen structure. *See* Fig 5. Also, *Kweon* describes the ball-point pen structure in terms of separate upper and lower sections: "The lower portion 21 and the upper portion 23 are engaged by screw portions formed in the lower and upper portions 21 and 32 respectively." Col. 3, lines 57-59. "That is, as only an upper portion of a ball-point pen is held on a pocket of a shirt by a clip for use." Col. 1, lines 57-60. As such, Kweon fails to teach or suggest "in which the front portion includes a radio transmitter," in the manner claimed.

For at least this reason, claim 3 is patentable over the cited art.

D. Applicant's Claim 23

Claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Fitch* in view of *Lin* in further view of *Kakita* (U.S. Patent No. 5,014,079). *Kakita* describes a camera that "automatically performs a release operation in accordance with a detected sound pressure level." Col. 9, lines 1-2.

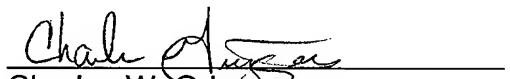
Because independent claim 1 is allowable over the cited art of record, dependent claim 23 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim 23 contains all the features of independent claim 1 and the cited art of *Kakita* fails to cure the deficiencies of the *Fitch* and *Lin* references in suggesting or teaching all of

the claimed features in claim 23. Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Fitch* in view of *Lin* in further view of *Kakita* has not been made with regard to claim 23, and, the rejections of claim 23 should be withdrawn.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied cited art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By: 

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A wearable electromagnetic (EM) radiation transmitter/receiver comprising:

a front portion;

a rear portion, wherein the front portion includes a transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is worn inside at least part of the wearer's clothing, the front and rear portions being operable to communicate with one another; and

a means to secure the front and the rear portion in position on a wearer's clothing, the securing means being configured when in use to be operable through a thickness of the wearer's clothing between the front and the rear portion.

2. A wearable transmitter/receiver as claimed in claim 1, wherein the securing means utilizes a magnet.

3. A wearable transmitter/receiver as claimed in claim 1, in which the front portion includes a radio transmitter.

4. A wearable transmitter/receiver as claimed in claim 1, in which the control section of the rear portion controls the transmission and reception sections.

5. A wearable transmitter/receiver as claimed in claim 1, in which the front portion comprises an image capture means.

6. A wearable transmitter/receiver as claimed in claim 5, in which the rear portion includes control means for the image capture means.

7. A wearable transmitter/receiver as claimed in claim 5, in which the rear portion also includes storage means for storage of captured images.

8. A wearable transmitter/receiver as claimed in claim 21, in which the pin is electrically conducting.

9. Canceled

10. A wearable transmitter/receiver as claimed in claim 8 in which the pin projects from the rear portion to be received in a corresponding opening in the front portion.

11. A wearable transmitter/receiver as claimed in claim 10, in which the electrically conducting connection pin has multiple conduction paths.

12. A wearable transmitter/receiver as claimed in claim 10, which includes a plurality of electrically conducting connection pins arranged to connect the front and rear portions.

13. A wearable transmitter/receiver as claimed in claim 1, in which the front portion is incorporated into a piece of jewelry.

14. A wearable transmitter/receiver as claimed in claim 1, in which the transmitter/receiver has a plurality of different front portions all being differently shaped to blend with, or be suitable with, a wearer's clothing and all being operable to be used with the same rear portion.

15-17. Canceled

18. A wearable electromagnetic (EM) radiation transmitter/receiver comprising:

a front portion and

a rear portion, wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is adapted to be worn inside at least part of the wearer's clothing, in which the front and rear portions are operable to communicate electrically with one another, and are physically connected to one another, in which the front and rear portions are electrically connected by means of an electrically conducting connection pin that penetrates the wearer's clothing and fixes the front and rear portions in place.

19. A wearable electromagnetic (EM) radiation transmitter/receiver comprising:

a front portion and

a rear portion, wherein the front portion includes transmission and reception sections and is adapted to be worn outside a wearer's clothing, and wherein the rear portion includes a control section and is adapted to be worn inside at least part of the wearer's clothing, in which the front and rear portions are operable to communicate electrically with one another, in which the front portion is secured to the rear portion and to the wearer's clothing by mating the front portion that is outside of the wearer's clothing with the rear portion that is inside the wearer's clothing via a securing means.

20. A wearable transmitter/receiver according to claim 1, wherein the securing means extends through the wearer's clothing between the front and rear portions.

21. A wearable transmitter/receiver according to claim 1, wherein the securing means comprises a pin.

22. A wearable transmitter/receiver as claimed in claim 1, wherein the front and the rear portions are operable to communicate through inductive coupling.

23. A wearable transmitter/receiver as claimed in claim 5, wherein the image capture means is triggered to capture an image in response to detecting laughter.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.